

105TH CONGRESS
1ST SESSION

H. R. 1661

To implement the provisions of the Trademark Law Treaty.

IN THE HOUSE OF REPRESENTATIVES

MAY 20, 1997

Mr. COBLE introduced the following bill; which was referred to the Committee
on the Judiciary

A BILL

To implement the provisions of the Trademark Law Treaty.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Trademark Law Trea-
5 ty Implementation Act”.

6 **SEC. 2. REFERENCE TO THE TRADEMARK ACT OF 1946.**

7 For purposes of this Act, the Act entitled “An Act
8 to provide for the registration and protection of trade-
9 marks used in commerce, to carry out the provisions of
10 certain international conventions, and for other purposes”,
11 approved July 5, 1946 (15 U.S.C. 1051 et seq.), shall be
12 referred to as the “Trademark Act of 1946”.

1 **SEC. 3. APPLICATION FOR REGISTRATION; VERIFICATION.**

2 (a) APPLICATION FOR USE OF TRADEMARK.—Sec-
3 tion 1(a) of the Trademark Act of 1946 (15 U.S.C.
4 1051(a)) is amended to read as follows:

5 “SECTION 1. (a)(1) The owner of a trademark used
6 in commerce may request registration of its trademark on
7 the principal register hereby established by paying the pre-
8 scribed fee and filing in the Patent and Trademark Office
9 an application and a verified statement, in such form as
10 may be prescribed by the Commissioner, and such number
11 of specimens or facsimiles of the mark as used as may
12 be required by the Commissioner.

13 “(2) The application shall include specification of the
14 applicant’s domicile and citizenship, the date of the appli-
15 cant’s first use of the mark, the date of the applicant’s
16 first use of the mark in commerce, the goods in connection
17 with which the mark is used, and a drawing of the mark.

18 “(3) The statement shall be verified by the applicant
19 and specify that—

20 “(A) the person making the verification believes
21 that he or she, or the juristic person in whose behalf
22 he or she makes the verification, to be the owner of
23 the mark sought to be registered;

24 “(B) to the best of the verifier’s knowledge and
25 belief, the facts recited in the application are accu-
26 rate;

1 “(C) the mark is in use in commerce; and

2 “(D) to the best of the verifier’s knowledge and
3 belief, no other person has the right to use such
4 mark in commerce either in the identical form there-
5 of or in such near resemblance thereto as to be like-
6 ly, when used on or in connection with the goods of
7 such other person, to cause confusion, or to cause
8 mistake, or to deceive, except that, in the case of
9 every application claiming concurrent use, the appli-
10 cant shall—

11 “(i) state exceptions to the claim of exclu-
12 sive use; and

13 “(ii) shall specify, to the extent of the ver-
14 ifier’s knowledge—

15 “(I) any concurrent use by others;

16 “(II) the goods on or in connection
17 with which and the areas in which each
18 concurrent use exists;

19 “(III) the periods of each use; and

20 “(IV) the goods and area for which
21 the applicant desires registration.

22 “(4) The applicant shall comply with such rules or
23 regulations as may be prescribed by the Commissioner.
24 The Commissioner shall promulgate rules prescribing the

1 requirements for the application and for obtaining a filing
2 date herein.”.

3 (b) APPLICATION FOR BONA FIDE INTENTION TO
4 USE TRADEMARK.—Subsection (b) of section 1 of the
5 Trademark Act of 1946 (15 U.S.C. 1051(b)) is amended
6 to read as follows:

7 “(b)(1) A person who has a bona fide intention,
8 under circumstances showing the good faith of such per-
9 son, to use a trademark in commerce may request reg-
10 istration of its trademark on the principal register hereby
11 established by paying the prescribed fee and filing in the
12 Patent and Trademark Office an application and a verified
13 statement, in such form as may be prescribed by the Com-
14 missioner.

15 “(2) The application shall include specification of the
16 applicant’s domicile and citizenship, the goods in connec-
17 tion with which the applicant has a bona fide intention
18 to use the mark, and a drawing of the mark.

19 “(3) The statement shall be verified by the applicant
20 and specify—

21 “(A) that the person making the verification be-
22 lieves that he or she, or the juristic person in whose
23 behalf he or she makes the verification, to be enti-
24 tled to use the mark in commerce;

1 “(B) the applicant’s bona fide intention to use
2 the mark in commerce;

3 “(C) that, to the best of the verifier’s knowl-
4 edge and belief, the facts recited in the application
5 are accurate; and

6 “(D) that, to the best of the verifier’s knowl-
7 edge and belief, no other person has the right to use
8 such mark in commerce either in the identical form
9 thereof or in such near resemblance thereto as to be
10 likely, when used on or in connection with the goods
11 of such other person, to cause confusion, or to cause
12 mistake, or to deceive.

13 Except for applications filed pursuant to section 44, no
14 mark shall be registered until the applicant has met the
15 requirements of subsections (c) and (d) of this section.

16 “(4) The applicant shall comply with such rules or
17 regulations as may be prescribed by the Commissioner.
18 The Commissioner shall promulgate rules prescribing the
19 requirements for the application and for obtaining a filing
20 date herein.”.

21 (c) CONSEQUENCE OF DELAYS.—Paragraph (4) of
22 section 1(d) of the Trademark Act of 1946 (15 U.S.C.
23 1051(d)(4)) is amended to read as follows:

24 “(4) The failure to timely file a verified statement
25 of use under paragraph (1) or an extension request under

1 paragraph (2) shall result in abandonment of the applica-
 2 tion, unless it can be shown to the satisfaction of the Com-
 3 missioner that the delay in responding was unintentional,
 4 in which case the time for filing may be extended, but for
 5 a period not to exceed the period specified in paragraphs
 6 (1) and (2) for filing a statement of use.”.

7 **SEC. 4. REVIVAL OF ABANDONED APPLICATION.**

8 Section 12(b) of the Trademark Act of 1946 (15
 9 U.S.C. 1062(b)) is amended in the last sentence by strik-
 10 ing “unavoidable” and by inserting “unintentional”.

11 **SEC. 5. DURATION OF REGISTRATION; CANCELLATION; AF-**
 12 **FIDAVIT OF CONTINUED USE; NOTICE OF**
 13 **COMMISSIONER’S ACTION.**

14 Section 8 of the Trademark Act of 1946 (15 U.S.C.
 15 1058) is amended to read as follows:

16 “DURATION

17 “SEC. 8. (a) Each registration shall remain in force
 18 for 10 years, except that the registration of any mark shall
 19 be canceled by the Commissioner for failure to comply
 20 with the provisions of subsection (b) of this section, upon
 21 the expiration of the following time periods, as applicable:

22 “(1) For registrations issued pursuant to the
 23 provisions of this Act, at the end of 6 years follow-
 24 ing the date of registration.

1 “(2) For registrations published under the pro-
2 visions of section 12(c), at the end of 6 years follow-
3 ing the date of publication under such section.

4 “(3) For all registrations, at the end of each
5 successive 10-year period following the date of reg-
6 istration.

7 “(b) During the 1-year period immediately preceding
8 the end of the applicable time period set forth in sub-
9 section (a), the owner of the registration shall pay the pre-
10 scribed fee and file in the Patent and Trademark Office—

11 “(1) an affidavit setting forth those goods or
12 services recited in the registration on or in connec-
13 tion with which the mark is in use in commerce and
14 such number of specimens or facsimiles showing cur-
15 rent use of the mark as may be required by the
16 Commissioner; or

17 “(2) an affidavit setting forth those goods or
18 services recited in the registration on or in connec-
19 tion with which the mark is not in use in commerce
20 and showing that any such nonuse is due to special
21 circumstances which excuse such nonuse and is not
22 due to any intention to abandon the mark.

23 “(c) The owner of the registration may make the sub-
24 missions required by this section, or correct any deficiency
25 in a timely filed submission, within a grace period of 6

1 months after the end of the applicable time period set
2 forth in subsection (a). Such submission must be accom-
3 panied by a surcharge prescribed therefor. If any submis-
4 sion required by this section filed during the grace period
5 is deficient, the deficiency may be corrected within the
6 time prescribed after notification of the deficiency. Such
7 submission must be accompanied by a surcharge pre-
8 scribed therefor.

9 “(d) Special notice of the requirement for affidavits
10 under this section shall be attached to each certificate of
11 registration and notice of publication under section 12(c).

12 “(e) The Commissioner shall notify any owner who
13 files 1 of the affidavits required by this section of the Com-
14 missioner’s acceptance or refusal thereof and, in the case
15 of a refusal, the reasons therefor.

16 “(f) If the registrant is not domiciled in the United
17 States, the registrant shall designate by a written docu-
18 ment filed in the Patent and Trademark Office the name
19 and address of some person resident in the United States
20 on whom may be served notices or process in proceedings
21 affecting the mark. Such notices or process may be served
22 upon the person so designated by leaving with that person
23 or mailing to that person a copy thereof at the address
24 specified in the last designation so filed. If the person so
25 designated cannot be found at the address given in the

1 last designation, such notice or process may be served
2 upon the Commissioner.”.

3 **SEC. 6. RENEWAL OF REGISTRATION.**

4 Section 9 of the Trademark Act of 1946 (15 U.S.C.
5 1059) is amended to read as follows:

6 “RENEWAL OF REGISTRATION

7 “SEC. 9. (a) Subject to the provisions of section 8,
8 each registration may be renewed for periods of 10 years
9 at the end of each successive 10-year period following the
10 date of registration upon payment of the prescribed fee
11 and the filing of a written application, in such form as
12 may be prescribed by the Commissioner. Such application
13 may be made at any time within 1 year before the end
14 of each successive 10-year period for which the registra-
15 tion was issued or renewed, or it may be made within a
16 grace period of 6 months after the end of each successive
17 10-year period, upon payment of a fee and surcharge pre-
18 scribed therefor. If any application filed during the grace
19 period is deficient, the deficiency may be corrected within
20 the time prescribed after notification of the deficiency,
21 upon payment of a surcharge prescribed therefor.

22 “(b) If the Commissioner refuses to renew the reg-
23 istration, the Commissioner shall notify the registrant of
24 the Commissioner’s refusal and the reasons therefor.

25 “(c) If the registrant is not domiciled in the United
26 States, the registrant shall designate by a written docu-

1 ment filed in the Patent and Trademark Office the name
2 and address of some person resident in the United States
3 on whom may be served notices or process in proceedings
4 affecting the mark. Such notices or process may be served
5 upon the person so designated by leaving with that person
6 or mailing to that person a copy thereof at the address
7 specified in the last designation so filed. If the person so
8 designated cannot be found at the address given in the
9 last designation, such notice or process may be served
10 upon the Commissioner.”.

11 **SEC. 7. RECORDING ASSIGNMENT OF MARK.**

12 Section 10 of the Trademark Act of 1946 (15 U.S.C.
13 1060) is amended to read as follows:

14 “ASSIGNMENT

15 “SEC. 10. (a) A registered mark or a mark for which
16 an application to register has been filed shall be assignable
17 with the good will of the business in which the mark is
18 used, or with that part of the good will of the business
19 connected with the use of and symbolized by the mark.
20 Notwithstanding the preceding sentence, no application to
21 register a mark under section 1(b) shall be assignable
22 prior to the filing of an amendment under section 1(c)
23 to bring the application into conformity with section 1(a)
24 or the filing of the verified statement of use under section
25 1(d), except for an assignment to a successor to the busi-
26 ness of the applicant, or portion thereof, to which the

1 mark pertains, if that business is ongoing and existing.
2 In any assignment authorized by this section, it shall not
3 be necessary to include the good will of the business con-
4 nected with the use of and symbolized by any other mark
5 used in the business or by the name or style under which
6 the business is conducted. Assignments shall be by instru-
7 ments in writing duly executed. Acknowledgment shall be
8 prima facie evidence of the execution of an assignment,
9 and when the prescribed information reporting the assign-
10 ment is recorded in the Patent and Trademark Office, the
11 record shall be prima facie evidence of execution. An as-
12 signment shall be void against any subsequent purchaser
13 for valuable consideration without notice, unless the pre-
14 scribed information reporting the assignment is recorded
15 in the Patent and Trademark Office within 3 months after
16 the date of the subsequent purchase or prior to the subse-
17 quent purchase. The Patent and Trademark Office shall
18 maintain a record of information on assignments, in such
19 form as may be prescribed by the Commissioner.

20 “(b) An assignee not domiciled in the United States
21 shall designate by a written document filed in the Patent
22 and Trademark Office the name and address of some per-
23 son resident in the United States on whom may be served
24 notices or process in proceedings affecting the mark. Such
25 notices or process may be served upon the person so des-

1 ignated by leaving with that person or mailing to that per-
 2 son a copy thereof at the address specified in the last des-
 3 ignation so filed. If the person so designated cannot be
 4 found at the address given in the last designation, such
 5 notice or process may be served upon the Commissioner.”.

6 **SEC. 8. INTERNATIONAL CONVENTIONS; COPY OF FOREIGN**
 7 **REGISTRATION.**

8 Section 44 of the Trademark Act of 1946 (15 U.S.C.
 9 1126) is amended—

10 (1) in subsection (d)—

11 (A) by striking “23, or 44(e) of this Act”
 12 and inserting “or 23 of this Act or under sub-
 13 section (e) of this section”; and

14 (B) in paragraphs (3) and (4), by striking
 15 “this subsection (d)” and inserting “this sub-
 16 section”; and

17 (2) in subsection (e), by striking the second
 18 sentence and inserting the following: “Such appli-
 19 cant shall submit, within such time period as may be
 20 prescribed by the Commissioner, a certification or a
 21 certified copy of the registration in the country of
 22 origin of the applicant.”.

23 **SEC. 9. TRANSITION PROVISIONS.**

24 (a) REGISTRATIONS IN 20-YEAR TERM.—The provi-
 25 sions of section 8(a) of the Trademark Act of 1946, as

1 amended by section 5 of this Act, shall apply to a registra-
2 tion for trademark issued or renewed for a 20-year term,
3 and existing on the effective date of this Act, on and after
4 the date that is 1 year before the date on which the 20-
5 year term expires.

6 (b) APPLICATIONS FOR REGISTRATION.—This Act
7 and the amendments made by this Act shall apply to any
8 application for registration of a trademark pending on, or
9 filed on or after, the effective date of this Act.

10 (c) AFFIDAVITS.—The provisions of section 8(b) of
11 the Trademark Act of 1946, as amended by section 5 of
12 this Act, shall apply to the filing of an affidavit if the sixth
13 anniversary of the registration, or publication under sec-
14 tion 12(c) of the Trademark Act of 1946, for which the
15 affidavit is filed is on or after the effective date of this
16 Act.

17 (d) RENEWAL APPLICATIONS.—The amendment
18 made by section 6 shall apply to the filing of an applica-
19 tion for renewal of a registration if the expiration date
20 of the registration for which the renewal application is
21 filed is on or after the effective date of this Act.

22 **SEC. 10. EFFECTIVE DATE.**

23 This Act and the amendments made by this Act shall
24 take effect—

- 1 (1) on the date that is 1 year after the date of
2 the enactment of this Act, or
3 (2) upon the entry into force of the Trademark
4 Law Treaty with respect to the United States,
5 whichever occurs first.

